REMARKS

United States Serial No. 10/523,845 was filed on July 29, 2005. The application is subject to a rejection of claims 1-18. In view of the amendments and remarks set forth herein, Applicant respectfully requests that the rejections of claims 1-18 be withdrawn and that a formal Notice of Allowance be issued with respect to claims 1-18.

Claim Amendments

Claims 10 and 18 have been amended to clarify the claimed subject matter. Support for these amendments can be found in the specification at page 3, lines 30-31. Applicant respectfully submits that the amended claims include limitations which should reasonably have been expected to be claimed, since they have been amended in response to a 35 U.S.C. § 112, second paragraph rejection.

A second or any subsequent action on the merits in any application should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

35 U.S.C. § 112

Claims 10 and 18 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is alleged that claims 10 and 18 recite a composition that dissolves in water within about 60 seconds, but that the speed at which the composition dissolves will depend on factors such as the temperature of the water, and whether the mixture is stirred; similarly, it is alleged that the pH of the solution will depend on the concentration of the composition. Therefore, it is alleged, it is not clear under which conditions the recited composition is supposed to dissolve in water within about 60 seconds to produce a solution wherein the pH is about 8 to about 8.5.

MPEP § 2173.02 states that

> [i]n reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 . . . (Fed. Cir. 2000).

Applicant respectfully submits that one of skill in the art would be apprised that the composition of claims 10 and 18 would dissolve in water within about 60 seconds in environmental conditions in which concrete is typically mixed. One of skill in the art would know that concrete compositions, as used in applications as described throughout the present specification, are typically mixed in normal exterior environmental conditions prior to being transmitted through a conduit, and that in such conditions, the temperature of the water used in mixing concrete does not change enough to appreciably alter the solubility of the claimed composition therein.

Further, since concrete compositions are typically mixed, one of skill in the art would recognize that, in order to allow the claimed composition to dissolve within 60 seconds, it may be necessary to agitate the composition after mixing it with water depending on the quantity of the composition added to the water, as described in the present specification at page 4, line 31 through page 5, line 2. However, one of skill in the art would also recognize that mixing may not always be required in order to allow the composition to dissolve in water within 60 seconds. In fact, at page 3, lines 18-20 of the present specification, it is stated that the composition dissolves rapidly in water. It dissolves so rapidly that, on page 4, lines 17-18, it is stated that the composition is optionally packaged in waterproof plastic bags in order to prevent hydration of the composition because it so easily dissolves.

Claims 10 and 18 have been amended to clarify that the concentration of the claimed composition provides the recited pH when added to water is about 1% to about 2% by weight based on the weight of water, as described in the present specification at page 3, lines 30-31.

Applicant respectfully submits that this amendment renders the allegations regarding the pH of the solution moot, and, in light of this amendment and the arguments set forth above, respectfully requests that the 35 U.S.C. § 112, second paragraph rejection of claims 10 and 18 be withdrawn.

35 U.S.C. § 103

Claims 2, 7-10 and 14-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 58-021489 to Matsumoto, et al. ("Matsumoto") in view of U.S. Patent No. 4,149,983 to Grier, et al. ("Grier") and U.S. Patent No. 4,461,712 to Jonnes ("Jonnes").

It is further alleged that Matsumoto discloses that, based on the total weight of the solid lubricating composition, the range of possible concentrations of bicarbonate is from 25 to 98% by weight and the range of possible concentrations of surfactant is 1.5 to 28% by weight. Matsumoto, at page 4, lines 17-20, discloses "an aqueous dispersing liquid, containing hydrogen carbonate in the range from 5 to 55 wt%, a dispersing agent in the range from 0.1 to 1.0 wt%, a surfactant in the range from 1 to 2 wt%, and optionally metallic soap or graphite less than 12 wt%."

MPEP § 2143.01(V) states that, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)". MPEP at 2100-140. There is no disclosure in Matsumoto that suggests that the solid components of the aqueous dispersing liquid ever exist as a mixture without water as a part of that mixture. Therefore, the dispersing liquid of Matsumoto that is used for hot and cold manufacturing processes of metal tubes (page 3, lines 1-3) as characterized in the Office Action, does not suggest a mixture of the non-aqueous components as a solid, as such a modification would render the disclosed dispersing liquid unsuitable for its intended purpose.

Combining Matsumoto with either or both of Grier and Jonnes does nothing to rectify the deficiency of Matsumoto described above. Throughout Grier, the disclosure focuses on fluid metalworking aids. Likewise, Jonnes discloses a "substantially neutral aqueous lubricant" (Abstract, emphasis added). Nowhere in either reference is it suggested that the metalworking aids/lubricants can be anything other than fluid compositions. Thus, Matsumoto, combined with Grier and Jonnes, requires the use of liquid lubricants. Since the modification of Matsumoto renders the prior art combination unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. Therefore, claims 2, 7-10 and 14-18 cannot be suggested by the prior art as alleged by the Office. Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2, 7-10 and 14-18.

Claims 3 and 11-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto, in view of Grier and Jonnes, and further in view of JP 60-001291 to Kuwamoto, et al. ("Kuwamoto").

The discussion of the deficiency in the combination of Matsumoto, Grier and Jonnes as set forth above is incorporated herein by reference. Including Kuwamoto with this combination does nothing to rectify the deficiency, as Kuwamoto discloses an aqueous-based metalworking fluid (Abstract). Further, Kuwamoto does not suggest the possibility of a non-aqueous based metalworking fluid. Therefore, for the reasons described above, claims 3 and 11-13 cannot be suggested by the prior art.

Applicant submits that, since claim 2 is not suggested by the combination of Matsumoto, Grier and Jonnes, for the above reasons, claims 3 and 11-13, which depend, either directly or indirectly, from claim 2, are also not suggested. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03 at page 2100-142.)

Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 3 and 11-13.

Claims 1 and 4-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,318,408 to Davidsson ("Davidsson"), in view of Matsumoto, Grier and Jonnes.

It is alleged, on page 6 of the Office Action, that "Matsumoto, Grier, and Jonnes disclose an aqueous lubricant useful for metal tubes." Applicant respectfully submits that this is not accurate. As discussed in the Office Action and above, Matsumoto, Grier and Jonnes refer to aqueous lubricants useful in processes for manufacturing metal tubes and/or pipes in order to protect the tubes/pipes and tools used to manufacture them from being damaged during manufacture. Therefore, there is no teaching, suggestion, or motivation that the lubricants would be useful during use of the metal tubes/pipes to transport any particular composition. Further, Matsumoto, Grier and Jonnes, as well as their combination do nothing to show that the compounds used are suitable for use with cementitious compositions, or that they would not be deleterious if used with cementitious compositions. For these reasons, there is no motivation to combine Davidsson with the combination of Matsumoto, Grier and Jonnes in order to provide a lubricant suspension useful in concrete conduits.

Therefore, Applicant respectfully submits that claims 1 and 4-6 are not rendered obvious by the combination of Matsumoto, Grier, Jonnes and Davidsson. Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1 and 4-6.

In view of the amendments and remarks set forth above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph rejection of claims 10 and 18 and the 35 U.S.C. § and 103(a) rejections of claims 1-18, and the issuance of a formal Notice of Allowance with respect to claims 1-9 and 11-17.

Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

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January 9, 2009
Date

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